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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,675	03/06/2002	Ronald W Waynant	4239-62279	9478
36218	7590	10/05/2004	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 S.W. SALMON STREET, SUITE #1600 ONE WORLD TRADE CENTER PORTLAND, OR 97204-2988			SOUW, BERNARD E	
			ART UNIT	PAPER NUMBER
			2881	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/070,675

Applicant(s)

WAYNANT, RONALD W

Examiner

Bernard E Souw

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A

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_


3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☒ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1-5, 7-17, 27 and 29-38.Claim(s) withdrawn from consideration: 6, 18-26 and 28.

8. ☒ The drawing correction filed on 06 March 2002 is a) ☒ approved or b) ☐ disapproved by the Examiner.  
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). filed 03/06/2002.  
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: the X-ray switch is not capable of performing the function as specified by applicant's invention/claims.



JOHN R. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800

### **ADVISORY ACTION**

1. The period for reply continues to run 4 MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

### ***Amendment***

2. The amendment after final rejection filed on 07/30/2004, along with in reply to the final rejection mailed on 05/24/2004 has been entered.

Claims 6, 18-26 and 28 have been cancelled.

Pending in this Office Action are claims 1-5, 7-17, 27 and 29-38.

No Request for Reconsideration under 37 CFR 1.116, or Request for Extension of Time under 37 CFR 1.136 has been received.

3. Applicant's Amendment filed 07/30/2004 is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

**Rejected claim(s): 1-5, 7-17, 27 and 29-38**

**INFORMATION DISCLOSURE STATEMENT**

4. The information disclosure statement filed 02/19/2004 fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

**Additional Prior Art**

5. Applicant has identified an article by R. Fitzgerald, "Ultrashort Laser Pulses Can Control X-Ray Switch" in Physics Today February 2002, pp. 16-18 (hereinafter Fitzgerald'2002), as an alleged evidence for the enablement of an X-ray switch recited in claims 1, 10, 27 and 33, which have been previously rejected under 35 USC §112 ¶.1. A copy of this document is attached to the 07/30/2004 amendment. However, this document is neither included in the IDS filed 03/06/2002, nor in the unconsidered IDS filed on 02/19/2004. Despite its status, the cited article has been fully considered by the examiner in this Office Action.

**Response to Applicant's Arguments**

6. Applicant's arguments filed 07/30/2004 along with the Extension of Time (considered as being filed under 37 CFR 1.136) have been fully considered, but they are not persuasive.

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► Claims 6, 18, 23 and 28 having been cancelled, their previous rejections under 35 USC §112 ¶.1 are now moot. However, claims 1, 10, 27 and 33 stand rejected under the same statute, because the alleged evidence cited by applicant, [Fitzgerald'2002], has failed to provide enablement for the pertinent claims. The X-ray signal that can be transmitted by the Fitzgerald'2002's device is an X-ray pulse, but **not** an X-ray image, as understood by one of ordinary skill in the art from Fig.2 and the text, in which a diffraction process is specified as the underlying mechanism of the transfer. In contrast, claims 1, 10, 27 and 33 recite the limitation of a single beam of X-ray radiation, which --upon interaction with an object-- carries an image of the object. Such an image cannot be carried by a single pulse of X-ray beam here enabled by the Fitzgerald'2002's device.

Although MPEP 2107.01/II states that to demonstrate patentable utility under §101 a commercially successful product is not required, nor is it essential that the invention accomplish all its intended functions or operate under all conditions, and the particular embodiment disclosed in the specification may thus lack perfection, the invented device must --however-- show a partial success and/or be capable to perform at least only crudely. This last criterion is not satisfied by applicant's invention, since Fitzgerald'2002's X-ray switch is not capable of transmitting an object image contained in a single beam of X-ray, as expressly recited in claims 1, 10, 27 and 33. Therefore, while the claims are not rejected under §101, their rejection under 35 USC §112 ¶.1 is proper.

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► Applicant's traversal of the rejections of claims 1-5, 7, 9-15, 27, 29-34 and 37-38 (3<sup>rd</sup> paragraph of pg.7-9 of 9) is based on the fact the cited prior art references "*fail to teach or suggest an X-ray time gate that captures an X-ray object image in response to a second pulse portion*". It must here be emphasized that applicant's invention, too, has evidently failed to provide enablement for the claimed limitation, i.e., "*to teach or suggest an X-ray time gate that captures an X-ray object image in response to a second pulse portion*", as recited above regarding the relevance of [Fitzgerald'2002] to applicant's invention. Therefore, applicant's argument is unpersuasive, and hence, claims 1-5, 7, 9-15, 27, 29-34 and 37-38 stand rejected under 35 USC §112 ¶.1, as already applied in the previous Office Action.

### **CONCLUSION**

7. For the reasons stated above, claims 1-5, 7-17, 27 and 29-38 are held *prima facie* obvious over the cited prior arts for reasons of record.

### **Communications**

45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard E Souw whose telephone number is 571 272 2482. The examiner can normally be reached on Monday thru Friday, 9:00 am to 5:00 pm..

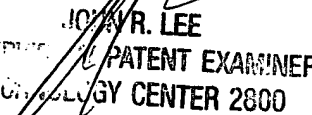
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee can be reached on 571 272 2477. The central fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications as well as for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.

bes  
September 22, 2004

  
J. LEE  
SUPERVISOR, PATENT EXAMINER  
TECHNOLOGY CENTER 2800